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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of April 27, 2005 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-25 are pending. The pending claims set forth a novel and non-obvious housing for a light fixture and method for fabrication of a light fixture. Reconsideration and allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Claims 1-4, 7-14, 17, 18, 21 and 23-25 were rejected under 35 U.S.C. §102(b) as being anticipated by Gawad et al. (U.S. Patent No. 4,494,175). Claims 1-4 and 7 were also rejected under 35 U.S.C. §102(b) as being anticipated by Lin (U.S. Patent No. 6,029,939). Claims 5, 6 and 22 were rejected as being unpatentable under 35 U.S.C. §103(a) over Gawad. Claims 15, 16, 19 and 20 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

The proposed amendment amends claims 1, 10, 11, 15, 17 and 23 and adds claims 26-30. The proposed amendment is fully supported by the specification to the application and does not include any new matter. Applicant now turns to the particular points raised by the Examiner in the Office Action of April 27, 2005.

Rejection of Claims 1-4, 7-14, 17, 18, 21 and 23-25 under 35 U.S.C. §102(b)

Claims 1-4, 7-14, 17, 18, 21 and 23-25 were rejected under 35 U.S.C. §102(b) as being anticipated by Gawad. Claims 1-4 and 7 were rejected as well as being anticipated by Lin. Claims 2-4, 7-14, 17, 18 and 21 are dependent to independent claim 1. Claims 24 and 25 are dependent to independent claim 23.

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Claim 1, as amended, requires a body having a sidewall with a plurality of fin-engaging elements and the interior surface of the sidewall to define an interior space within which power-related components are secured. Anticipation requires that the identical invention to that contained in a claim be described in a single prior art reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ 2d 1913 (Fed. Cir. 1989).

The Examiner in the Office Action points to a body 17 as having a sidewall 20 with a plurality of fin-engaging elements in Fig. 3 of the reference. This structure is, however, actually a channel strip 17 whose interior is closed off by its attachment to top plate 12. (Gawad at col. 4, lines 1-6). Although not clearly identified by the Examiner, the supposed fin-engaging elements he references in Gawad appear to be slots on opposing side sections 50, not channel strip 17. Side sections 50 are joined with end sections 52 to form the sidewall of louver assembly 20. The slots are associated with four cross pieces (fins) 62 inside the assembly that are used to provide light control for the lighting fixture. (Gawad at col. 5, lines 4-14). When the fixture is assembled, louver assembly 20 removably hangs from top plate 12 while resting upon grid rails 32. (Gawad at col. 5, line 15 to col. 6, line 4).

Gawad does not teach power-related components being secured within the space defined by the interior surfaces of sections 50. Power-related components, as defined by this application, would include ballasts, capacitors, ignitors or other devices needed to create the proper electrical power for lighting fluorescent lamp 28 shown in the reference. Such components, if present, are presumably located within channel strip 17 and apart from louver assembly 20.

Amended claim 1 also requires at least one fin removably engaged with at least one of the fin-engaging elements and extending outward from the exterior surface of the sidewall. These elements are not disclosed by Gawad as well. Each cross piece 62 is shown extending between side sections 50 with no portion extending outward from either section's exterior surface. (Gawad in Figs. 1-6). In addition, nothing is taught within the reference to support any inference that the cross pieces are removably engaged when secured to side sections 50.

The features of independent claim 1, as amended, are also not found within Lin. Lin is directed to a pedestal for a household duster, not a lighting fixture. Power-related components

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are therefore clearly not disclosed by that reference and, in particular, are not disclosed secured within the interior space defined by the interior surface of the sidewall to main body 1.

Since all of the limitations of independent claim 1, as amended, are not found in either Gawad or Lin, Applicant submits that each of the rejections of claim 1 have been overcome and asks that amended claim 1 and each of the claims dependent to it be allowed.

Dependent claim 3 is directed to a housing for a light fixture having a plurality of fins equivalent to the plurality of fin-engaging elements. This claim is allowable at least by virtue of its dependency from amended claim 1. In addition, however, this limitation is neither taught or suggested by Gawad. The reference shows at least two slots for each cross piece 62. (Gawad at Fig. 1). For this reason, Applicant asks that the specific rejection of claim 3 as anticipated by Gawad be withdrawn.

Dependent claim 4 adds the limitation that the housing have a plurality of fins less than the plurality of fin-engaging elements so that the fins are selectively placed around the sidewall of the body. This claim is patentable at least by virtue of its dependency from amended claim 1. In addition, however, this additional feature is not disclosed by either Gawad or Lin. Although the number of cross pieces in Gawad is less than the number of apparent slots as pointed out above, there is no teaching or suggestion in that reference to support a showing that some and not all of the cross pieces may be selectively placed along side sections 50. Lin, on the other hand, has a equal number of fins and slots; nothing is therefore taught or suggested regarding selective placement of some and not all of the fins during assembly of the pedestal. This lack of anticipation by both Gawad and Lin supports specific withdrawal by the Examiner of the rejection of claim 4.

Each of the restrictions added by claims 9-14, 17, 18 and 21 are not suggested, much less described, by Gawad. Each of these claims is allowable at least by virtue of their dependence to amended claim 1. Gawad specifically does not disclose, however, a substantially cylindrical sidewall as claimed in claim 9 but teaches instead parabolically contoured and substantially planar side sections. Although the Examiner points to Fig. 3 in support of his rejection, this drawing shows no cylindrical sidewall. Having no cylindrical sidewall, Gawad likewise cannot

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disclose slots placed equidistantly around the circumference of that sidewall as set forth in claim 10.

Claim 11 requires each fin to have at least one stop extending from a rear edge, a structure not taught in Gawad for any of its cross pieces. Extension plate 70 is pointed to by the Examiner as showing such a stop. Plate 70 has no connection to or attachment with cross pieces 62 but is rather fastened to end section 52 of louver assembly 20. Claim 12 adds the further element that each slot have a catch attached to the interior surface of the sidewall which is another feature not disclosed by this reference. End piece 15 does not, contrary to what is stated by the Examiner in the Office Action, disclose a catch since that structure has no relationship to side sections 50 and certainly has no attachment to the interior surface of those sections.

Claims 13 and 14 are dependent to claims 11 and 12 and are allowable at least by virtue of the lack of anticipation of those claims. They are directed to specific embodiments of the stop and catch already missing from Gawad. Claim 13 also requires, however, that each slot run substantially the length of the sidewall and not its width as shown in Gawad. In addition, claim 14 includes the limitation of a set screw for firmly securing each fin in position. No such set screw is disclosed by the reference cited by the Examiner in support of his rejection of this claim.

Claim 17 adds the requirement that the fin-engaging elements of the sidewall be grooves extending along the exterior surface of the sidewall. No such structure is disclosed by Gawad. Moreover, the Office Action is silent as to the feature of the lighting fixture in Gawad that anticipates this element. This is contrary to 37 CFR §1.104(c)(2). The Examiner must designate as near as practical the particular part of the reference that he relies upon in support of his rejection.

Claims 18 and 21 are dependent to claim 17 and are allowable at least by virtue of the lack of anticipation of claim 17. Claim 18 adds, however, the limitation that the sidewall be substantially cylindrical which, as pointed out above with respect to the allowance of claim 9, is not anticipated by Gawad.

Independent claim 23 is a method claim directed to fabricating a light fixture with selective and exchangeable fins. Claims 24 and 25 are dependent to it. Claim 23, as amended,

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requires at least that the interior space defined by the interior surface of the sidewall have power-related components and that a fin be removably engaged with at least one of the sidewall's fin-engaging elements, extending outward from the exterior surface of the sidewall. For the reasons stated above with respect to the allowance of claim 1, none of these elements are described or disclosed by Gawad.

In addition, however, selective and exchangeable fins are not taught or suggested by the cited reference. The structures identified by the Examiner as corresponding to the claimed fins are simply four cross pieces 62 positioned within the Gawad louver assembly 20. These pieces extend between and interconnect side sections 50 to provide light control for the disclosed fixture. No alternative cross pieces to those shown in Fig. 1 are described for exchange with those pieces. Likewise, there is no teaching of any selective placement of these pieces when positioned within the louver assembly.

Claim 24 adds the step of choosing the fin from a group of fins of differing character. This step is neither described nor disclosed by Gawad. As stated above, only one type of cross piece is shown in Fig. 1 or in any of the other drawings. Moreover, the Office Action is silent as to the feature of the lighting fixture disclosed by Gawad that the Examiner considers to anticipate this element. The Examiner has therefore failed in his duty to make as near as practical the required designation of the particular part of the reference that he relies upon in support of his rejection. 37 CFR §1.104(c)(2).

Claim 25 includes the limitation that there be a plurality of fins less than the plurality of fin-engaging elements so that selected placement of the fins around the sidewall is possible. This claim is allowable at least by virtue of its dependency from claim 23 in overcoming the rejection by the Examiner for the reasons stated above. In addition, however, the limitation added in claim 25 is similar to the restriction in claim 4. For each of the reasons given earlier with respect to the allowance of claim 4, this element is also neither described nor disclosed by Gawad.

For all of these reasons, Applicant respectfully asks that the rejections of claims 1-4, 7-14, 17, 18, 21 and 23-25 as being anticipated under 35 U.S.C. §102(b) be withdrawn and that each of these claims be allowed.

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Rejection of Claims 5, 6 and 22 under 35 U.S.C. §103(a)

Claims 5, 6 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gawad. The Examiner acknowledges that Gawad does not disclose a light fixture having fins differing from one another in shape, color or material (claim 5) or having fins with a surface displaying indicia (claim 6). The Examiner states only that it would have been obvious to one having ordinary skill in the art to provide fins with different shapes, colors, material or indicia. He cites In re Leshin, 47 CCPA 911, 125 USPQ 416 (1960) in support of the proposition that it is within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

The Examiner's reliance, however, on the decision in In re Leshin is misplaced. Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). There must be more of a justification for modifying a piece of prior art than solely the fact that it happened to have been known at the time of the invention. The mere fact that a reference can be modified does not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. MPEP §2143.01.

A specific explanation why a skilled artisan would have been motivated to make a claimed modification must be set forth by an examiner after any rejection under 35 U.S.C. §103. MPEP §706.02(j). There is no showing in the present Office Action, however, of any reasons or motivation within Gawad to support the modification the Examiner relies upon for his rejection of claims 5, 6 and 22. The Examiner simply calls upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the selection and modification of Gawad. This is not the showing required under the MPEP but rather an exercise in hindsight frowned upon by the courts since an examiner may not simply select from the prior art the needed components of a

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claimed invention through the use of the blueprint supplied by the inventor. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985).

Moreover, the ruling in In re Leshin is far more limited than the broad holding attributed to it by the Examiner. Appellant in that decision claimed a device for dispensing cosmetics in solid form. The device included a container made from molded plastic materials. Although the prior art showed a similar container of molded plastic and appellant conceded using well-known plastics in his device, appellate continued to contend that those claims limited to plastic were still patentable because he had to select the plastics used for his particular purpose. The court responded to this argument by ruling: "Mere selection of known plastics to make a container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on the basis of suitability for the intended use, would be entirely obvious; and in view of 35 U.S.C. 103 it is a wonder that the point is even mentioned." In re Leshin 125 USPQ at 417.

Claims 5, 6 and 22 are not directed to limitations where the point of novelty is no more than the selection of a particular type of material for a structure taught in the prior art made of that class of material. In particular, Gawad does not teach or describe "fins" designed in varying shapes, having varying color, made from varying materials, displaying varying indicia, or varying from one to the other within the same apparatus. Claims 5 and 6 represent therefore anything but a "mere selection" of such features from "fins" of a similar type made prior to the time of this invention.

In addition, Gawad teaches against modifying the cross pieces in the manner suggested. To do so would create a lighting fixture that could lose its ability to provide light control within the louver assembly. (Gawad at col.5, lines 11-14; Fig. 1). The cross pieces in the reference cited by the Examiner are uniformly designed structures needed to extend between and thus interconnect side sections of the assembly. Nowhere in Gawad is there a teaching that varying the cross pieces from each other in shape, color or material or in having the cross pieces display indicia on their surfaces is, in any manner, needed or desirable. The modification proposed by the Examiner could make the lighting fixture in Gawad highly unsatisfactory for its obviously intended purpose.

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The Examiner in the Office Action never clearly explains the pertinence of Gawad nor points out the particular portion of that reference that he relies upon in support of his rejection of claim 22. As stated earlier, this is contrary to 37 CFR §1.104(c)(2). By making his rejection based on obviousness, the Examiner seems to acknowledge at the very least the absence of any teaching in Gawad of the limitation that the body is formed by an extrusion process. There is no showing, however, in the Office Action of any reasons or motivation within Gawad to support the modification relied upon by the Examiner for his rejection. The Examiner rather calls upon the subjective basis of engineering expediency to arrive at the necessary motivation for modification of this reference. This is once again not the specific and objective explanation required to be set forth under MPEP §706.02(j) but an exercise in inappropriate hindsight.

This lack of any showing by the Examiner of the motivation needed for one skilled in the art to select and then modify Gawad, along with the other reasons discussed above, establishes that a prima facie case of obviousness has not been made by him to maintain the rejections of claims 5, 6 and 22. Applicant believes therefore that these rejections should be withdrawn and that each of these claims should be allowed.

New Claims

Applicant appreciates the indication of allowable subject matter in claims 15, 16, 19 and 20. Claim 26 is a new independent claim comprising the limitations of claim 16 and specific limitations drawn from claim 1 and the intervening claims to which claim 16 is dependent.

Claim 27 is a new independent claim incorporating the limitations of claim 15 and specific limitations from claim 1. Claim 28 is dependent to claim 27 and adds certain limitations from claims 7, 11, 12 and 13 to which claim 15 is dependent. Claim 29 is dependent to claim 27 and adds limitations from claims 17 and 19. Claim 30 is dependent to claim 29 and includes the limitations from claim 20.

Each new claim is not anticipated or made obvious by any of the references cited by the Examiner. Each is in condition for immediate allowance.

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Conclusion

Applicant's invention, as set forth in the pending claims, represents a highly novel housing for a light fixture and method for fabricating a light fixture. Applicant believes that now pending claims 1-30 each have elements not disclosed or suggested in the prior art. Applicant respectfully submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

Respectfully submitted,



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